

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Response to March 14, 2005 Office Action

REMARKS

The United States Patent and Trademark Office (the "Office") rejected claims 1, 3, 5-9, 11-17, 21, and 22 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,768,789 to Wilk. Claims 2 and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Wilk. Claim 4 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Wilk. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Wilk in view of U.S. Patent 6,666,376 to Ericson. The Assignee shows, however, that the pending claims are neither anticipated, nor obviated, by the cited documents. The Assignee, then, respectively submits that the pending claims are ready for allowance.

Rejection of Claims Under 35 U.S.C. § 102

The Office rejected claims 1, 3, 5-9, 11-17, 21, and 22 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,768,789 to Wilk. A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the pending claims distinguish over Wilk. The reference to Wilk does not anticipate the claims, so the Assignee respectfully requests allowance of these claims.

Independent claims 1, 9, 21, and 22 are not anticipated. The independent claims have been amended to incorporate features originally presented in the dependent claims. The independent claims, for example, recite "communicating the pre-created data message to the originating party." The patent to Wilk fails to teach or suggest such a feature. Wilk, in contradistinction, sends a prerecorded outgoing voice message to the calling party. As Wilk explains, the callee prerecords one or more voice messages. See U.S. Patent 6,768,789 to Wilk (Jul. 27, 2004) at column 4, lines 18-25. When a call is received, the callee makes a selection and the selected message is then "played to the caller." *Id.* at column 4, lines 57-62. Wilk does

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Response to March 14, 2005 Office Action

not "communicat[e] the pre-created data message to the originating party." The reference to *Wilk*, then, cannot anticipate the claims.

Wilk does mention text-to-speech messages. *Wilk* explains that the callee may prepare a text message for the calling party. See *id.* at column 7, lines 48-50. The text message, however, is then converted to speech "using a text-to-speech generator." *Id.* at column 7, lines 49-51. So, *Wilk* still communicates a voice message to the calling party. *Wilk* does not "communicat[e] the pre-created data message to the originating party" and, thus, cannot anticipate the claims.

Rejection of Claims Under 35 U.S.C. § 103

Claims 2, 4, and 10 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk*. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to Ericson. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the pending claims are not obvious in view of *Wilk* and/or *Ericson*. The Assignee, then, respectfully requests allowance of the claims.

Claims 2, 4, and 10 are not obvious. These claims incorporate the same patentably distinguishing feature "communicating the pre-created data message to the originating party." The patent to *Wilk* fails to teach or suggest such a feature. *Wilk*, as earlier explained, sends a prerecorded outgoing voice message to the calling party. *Wilk* does not communicate a pre-created data message to the originating (e.g., calling) party. Because *Wilk* fails to teach or suggest such a feature, one of ordinary skill in the art would not think the claims obvious. The

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Response to March 14, 2005 Office Action

Examiner's *prima facie* case must fail, so the Assignee respectfully asks the Office to remove the rejection.

Claims 18-20 are, likewise, not obvious. These claims recite the same patentably distinguishing feature "communicating the pre-created data message to the originating party." Because the proposed combination of *Wilk* and *Ericson* fails to teach or suggest such a feature, one of ordinary skill in the art would not think the claims obvious. The Examiner's *prima facie* case must fail, so the Assignee respectfully asks the Office to remove the rejection.


Next Office Action

Applicants respectfully submit that the amendments made herein should not provide cause for the next office action to be made final. The independent claims have been amended to incorporate features originally presented in dependent claims. Claim 1, for example, has been amended to incorporate features originally presented in dependent claim 7. Independent claim 9, likewise, has been amended to incorporate features originally presented in claim 14. Claims 21 and 22 have also been amended to incorporate the same features. Thus, the amendments made herein would not necessitate any new grounds of rejection to cause the next office action to be made final.

For at least the foregoing reasons, pending claims 1-6, 8-13, and 15-22 are considered allowable, and a Notice to this effect is respectfully solicited. If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,

BS00097 CIP I
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Response to March 14, 2005 Office Action

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390